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REMARKS

Claims 1-30 are pending in the present application. Claims 13-30 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter and because the disclosed invention is inoperative and lacks utility. Claims 1-12 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by U.S. Patent No. 7,028,190 to Burakoff et al. ("Burakoff"). Claims 13-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Burakoff.

Rejection of Claims 13-30 Under 35 U.S.C. § 101

Claims 13-30 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter and because the disclosed invention is inoperative and lacks utility. These rejections are respectfully traversed.

Claims 13-30 are directed to statutory subject matter. On page 2 of the Office Action, the Examiner asserts:

The claims are nonfunctional descriptive material, per se. There is no computer-readable medium recited and even if there was a medium, the information recited, i.e. 'first record', 'second record', 'first graphical representation' is not functional descriptive material. In other words, this is not directed to an executable program or a data structure that would control a computer, it is just a collection of data stored on a computer readable medium. Such a collection of data is not capable of imparting functionality when acted upon by a computer.

Contrary to the Examiner's assertion that "there is no computer-readable medium recited," claim 13 recites, "A computer program product ... comprising: a computer-readable medium." (emphasis added). The undersigned representative directs the Examiner to the actual claim language, which clearly recites the "computer-readable medium" that the Examiner asserts is not recited.

The Examiner further asserts that the information recited is not functional descriptive. According to MPEP § 2106.01, "'functional descriptive material' consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of 'data structure' is 'a physical or logical relationship among data elements, designed to support specific data manipulation functions.'" Further, "a

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claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." MPEP § 2106.01. Additionally, the presence of any claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. In an example provided by the Patent Office, "a computer that recognized a particular grouping or sequence of musical notes read from memory and thereafter causes another defined series of notes to be played, requires a functional interrelationship among that data and the computing processes performed when utilizing the data. As such, a claim to that computer is statutory subject matter because it implements a statutory process." *Id.*

Claim 13 recites a functional interrelationship between the data structures and the computer software. For example, claim 13 recites, "a second graphical representation of a second data structure stored on the medium, the second graphical representation transmitted by a second module in response to the first exercise to prompt a consent for an electronic delivery of the stored information." Claim 13 clearly recites a physical or logical relationship among data elements, designed to support specific data manipulation functions. Additionally, similar to the "musical note" example recited in MPEP § 2106.01, claim 13 discloses a computer program product that causes an action (e.g., transmitting the stored information) to occur upon an action (e.g., third exercise), for example, by reciting, "the fourth graphical representation transmitting the stored information in response to the third exercise."

On page 4 of the Office Action, the Examiner indicates that that claim 13 is functional, in contrast to the rejection of claims 13-30 under § 101 on page 2. "As per claim 1 analysis, Barakoff teaches all functional elements of claim 13." Office Action at page 4 (emphasis added). Clearly, the Examiner recognizes the function of claim 13. Therefore, the undersigned representative submits that claims 13-30 are directed to statutory subject matter.

Claims 13-30 are operative and satisfy the "utility" requirement. First, the Examiner has only provided an assertion that the "the disclosed invention is inoperative and lacks utility." This assertion is not supported by any explanation of § 101 and is inconsistent with the Examiner's own language in other parts of the Office Action. For example, on page 4 of

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the Office Action, with regards to the rejection of claims 13-30 under § 103, the Examiner states, "Burakoff fails teach (sic) that the process is presented in a form of graphical representation of various data structure communicated using programmed computer modules ... communicating commercial transaction data and other information in the form of graphical information and allowing the recipient of the information to access via graphical display," which clearly has a stated utility.

Second, claim 13 recites a "useful" invention according to its proper meaning of § 101 by operating to produce the results claimed. *See, e.g., Newman v. Quigg*, 877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989); *In re Harwood*, 390 F.2d 985, 989, 156 USPQ 673, 676 (CCPA 1968). "To violate [35 U.S.C.] 101 the claimed device must be totally incapable of achieving a useful result." *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992) (emphasis added). *See also E.I. du Pont de Nemours and Co. v. Berkley and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980) ("A small degree of utility is sufficient ... The claimed invention must only be capable of performing some beneficial function ... An invention does not lack utility merely because the particular embodiment disclosed in the patent lacks perfection or performs crudely ... A commercially successful product is not required ... Nor is it essential that the invention accomplish all its intended functions ... or operate under all conditions ... partial success being sufficient to demonstrate patentable utility ... In short, the defense of non-utility cannot be sustained without proof of total incapacity.") If an invention is only partially successful in achieving a useful result, a rejection of the claimed invention as a whole based on a lack of utility is not appropriate. *See In re Brana*, 51 F.3d 1560, 34 USPQ2d 1435 (Fed. Cir. 1995); *In re Gardner*, 475 F.2d 1389, 177 USPQ 396 (CCPA), *reh'g denied*, 480 F.2d 879 (CCPA 1973); *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971). Accordingly, the Examiner is essentially asserting that there is no useful result – that the invention in claim 13 is totally incapable of achieving a useful result. However, the Examiner has not provided any explanation of how this invention is inoperative. Examples of the rare inoperative cases include instances where the utility asserted by the applicant was thought to be "incredible in the light of the knowledge of the art, or factually misleading," *In re Citron*, 325 F.2d 248, 253, 139 USPQ 516, 520 (CCPA

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1963), or the asserted utility is inconsistent with known scientific principles or is "speculative at best" as to whether attributes of the invention necessary to impart the asserted utility were actually present in the invention. *In re Sichert*, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977). Based upon the factual record in this case, the Examiner has not proven or even properly asserted that the invention could not work as the inventor claims.

Hence, independent claim 13 is useful and operative under § 101. Since claims 14-30 are dependent on allowable independent claim 13, dependent claims 14-30 are allowable as well. For at least these reasons, independent claim 13, as well as dependent claims 14-30, are patentable in view of § 101. It is respectfully submitted that the rejection of claims 13-30 under 35 U.S.C. § 101 be withdrawn.

Rejection of Claims 1-12 Under 35 U.S.C. § 102(e)

Claims 1-12 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Burakoff. This rejection is respectfully traversed.

On page 3 of the Office Action, the Examiner states, "As per claim (sic) Burakoff teaches a Method and System for delivery of sensitive information. As such Burakoff teaches critical steps of the invention including the first exercise, the second exercise and the third exercise by the recipient of the sensitive information." The Examiner refers to the entire Description in Burakoff, as well as Figure 5. The Examiner also states that "all process steps if (sic) the claimed invention are explicitly disclosed or inherent in the Burakoff reference."

The Examiner has not established a *prima facie* case of anticipation under § 102. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Referring to Figure 5 and as the figure is described in the Description, Burakoff does not disclose responsive to the exercised granting of the requested consent, providing an

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electronic access to the received information,” as recited in claim 1. Burakoff recites that once a query is sent to the user or a URL directing the user to the location of sensitive information, the user decides whether or not to consent to electronic delivery. Col. 10, lines 41-52. If the user consents, however, Burakoff does not perform the step of “responsive to the exercised granting of the requested consent, providing an electronic access to the received information,” as recited in claim 1. Instead, Burakoff sends a test document to test the ability of the user to receive such a document. “If the user does consent to electronic delivery then the information host may send the user a test document 560. If the user is unable to receive the test document then the consent may begin again. If the user is able to receive the test document then consent may be established by 564, and further sensitive information may be delivered electronically, 566.” Col. 10, lines 53-60. The method of claim 1 does not require this step as required by Burakoff.

Furthermore, after “providing an electronic access to the received information,” claim 1 recites the steps of “receiving a third exercise of the provided electronic access to the received information; and responsive to the exercised electronic access to the received information, providing the received information,” neither of which are explicitly disclosed or inherent in Burakoff. In contrast, once Burakoff establishes that the test document has been received, “further sensitive information may be delivered electronically.” Col. 10, lines 57-60. First, Burakoff is directed at further information, which indicates that sensitive information has already been provided and the user is consenting to receive additional sensitive information. “Once the consent is received at the server system, the consent is stored and sensitive information is delivered electronically to an e-mail address specified by the user.... Having secured the individual’s consent, the additional sensitive information may be delivered to the individual’s computer as, for example, a URL attachment to an email message.” Abstract. Claim 1, on the other hand, “provides the received information” “responsive to a third exercise of the provided electronic access to the received information.” Second, Burakoff does not disclose a “third exercise” as recited in claim 1. Referring to Figure 5 and as cited above, once the user is able to receive the test document, the additional sensitive information is sent electronically. Although Burakoff and claim 1 appear to be

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similarly directed to consent for receiving information, Burakoff does not disclose each and every step recited in claim 1.

In addition to those features that are not explicitly disclosed by Burakoff, the Examiner has not properly established that Burakoff inherently discloses any or all of the remaining features of claim 1 that may not be explicitly disclosed. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See MPEP § 2112.

By identifying how Burakoff does not disclose or even necessarily possess all of the elements of claim 1, the undersigned representative has rebutted any *prima facie* case that the Examiner may have established. The *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433; MPEP § 2112.01; *see also Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

Therefore, the Examiner has failed to provide a basis of fact and/or sufficient technical reasoning why Burakoff inherently discloses each and every element besides a first exercise, second exercise, and third exercise. Therefore, the Office Action has not meet its burden of proof that Burakoff anticipates claims 1-12 of the present application.

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Hence, Burakoff does not disclose all the claim limitations of independent claim 1 of the present application. Since claims 2-12 are dependent on allowable independent claim 1, dependent claims 2-12 are allowable as well. Therefore, the Examiner has not established a *prima facie* case of anticipation with respect to claims 1-12 of the present application.

For at least these reasons, independent claim 1, as well as dependent claims 2-12, are patentable over the cited art. It is respectfully submitted that the rejection of claims 1-12 under 35 U.S.C. § 102(e) be withdrawn.

Rejection of Claims 13-30 Under 35 U.S.C. § 103(a)

Claims 13-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Burakoff. This rejection is respectfully traversed.

On page 4 of the Office Action, the Examiner states that "As per claim 1 analysis, Burakoff teaches all functional elements of claim 13." However, the Examiner has not properly established a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 2 USPQ2d 1438 (Fed. Cir. 1991).

Pursuant to the requirements for establishing a *prima facie* case of obviousness under 35 U.S.C. § 103, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Referring to MPEP Section 2142,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

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claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. *In re Vaecik*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(emphasis added). The Examiner has not established that Burakoff teaches or suggests all of the claim limitations.

As similarly stated above with respect to the rejection of claims 1-12 under 35 U.S.C. § 102, claim 13 is allowable because Burakoff, for example, does not teach or suggest "response to the second exercise of the granting of the prompted consent to provide an electronic access to the received information," as recited in claim 13. For at least these reasons identified above, Burakoff does not teach or suggest each and every element of claim 13.

Additionally, on page 4 of the Office Action, the Examiner recognizes that "Burakoff fails to teach that the process is presented in a form of graphical representation of various data structure communicated using programmed computer modules." In order to cure this deficiency of Burakoff, the Examiner improperly takes Official Notice.

Official Notice is taken that communicating commercial transaction data and other information in the form of graphical information and allowing the recipient of the information to access via graphical display is old and well known. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Burakoff by implementing graphical representation of various data structures required in the electronic delivery system and recited in the instant claims because this would facilitate easy access to the information and more efficient and faster response to the requested information from the recipient of the sensitive information.

Office Action at page 4. The Examiner's Official Notice is purely conclusory and fails to provide the proper motivation to modify Burakoff.

It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."); MPEP § 2144.03 (emphasis added).

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The Examiner does not provide the proper motivation to modify Burakoff. Significantly, it has been judicially held that generalizations do not establish the requisite motivation to modify a specific reference in a specific manner to arrive at a specifically claimed invention. *See In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1410 (Fed. Cir. 1995). The Examiner's conclusory statements are inappropriate without the Examiner providing specific factual findings predicated on sound technical and scientific reasoning to support the Examiner's conclusory statements. The Examiner is relying on conclusory statements and has not provided proper motivation to modify Burakoff, thus the Examiner has not met his burden of establishing a *prima facie* case of obviousness.

In one example, the Official Notice fails to cure the deficiencies of Burakoff in teaching or suggesting "a third graphical representation of a third data structure stored on the medium, the third graphical representation transmitted by a third module in response to the second exercise of the granting of the prompted consent to provide an electronic access to the stored information," as recited in claim 13. Burakoff does not teach or suggest this element, as stated by the Examiner, and the Official Notice, even if factually supported, does not properly cure the deficiency. It is not obvious to modify Burakoff to implement a first graphical representation, a second graphical representation, a third graphical representation, and a fourth graphical representation.

Hence, Burakoff does not teach or suggest all the claim limitations of independent claim 13 of the present application. Since claims 14-30 are dependent on allowable independent claim 13, dependent claims 14-30 are allowable as well. Therefore, the Examiner has not established a *prima facie* case of obviousness with respect to claims 13-30 of the present application.

For at least these reasons, independent claim 13, as well as dependent claims 14-30, are patentable over the cited art. It is respectfully submitted that the rejection of claims 13-30 under 35 U.S.C. § 103(a) be withdrawn.

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CONCLUSION

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned representative, in person or over the telephone, we welcome the opportunity to do so. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account No. 501458.

Respectfully submitted,

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